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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/381,508	09/21/1999	PAUL DAVID METCALFE	1749-258	4047

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EXAMINER

BOCHNA, DAVID

ART UNIT PAPER NUMBER

3679

DATE MAILED: 06/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/381,508

Applicant(s)

METCALFE, PAUL DAVID

Examiner

David E. Bochna

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6 and 16-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6 and 16-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Response to Arguments

1. In view of the response filed on 5/28/02, PROSECUTION IS HEREBY REOPENED. A new rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

2. Applicant's arguments with respect to claims 1, 3-6 and 16-26 have been considered but are moot in view of the new ground(s) of rejection.

Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

(a) TITLE OF THE INVENTION.

(b) CROSS-REFERENCE TO RELATED APPLICATIONS.

(c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.

(d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program

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listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or

REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)

(e) BACKGROUND OF THE INVENTION.

(1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(f) BRIEF SUMMARY OF THE INVENTION.

(g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(h) DETAILED DESCRIPTION OF THE INVENTION.

(i) CLAIM OR CLAIMS (commencing on a separate sheet).

(j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

The applicant submitted a substitute specification on 1/17/02 along with replacement paragraphs that were to be added into the substitute specification. The examiner is requesting that the applicant submit both a clean version and a marked up version of the substitute specification with the replacement paragraphs already included in the substitute specification so that there are no questions as to where the replacement paragraphs should be placed.

Claim Objections

1. Claims 16-18, 20-26 are objected to because of the following informalities: The use of the words "tubular" and "tubulars" appears to be grammatically incorrect. The words "tubular" and "tubulars" are adjectives, however they are used as nouns in the above listed claims.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 3-6 and 16-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 7, it is if the phrase "the slots" refers to "the slots" of the tubular connector or the "slots of the expandable tubing.

Claim 1 recites the limitation "the end most" in line 12. There is insufficient antecedent basis for this limitation in the claim.

Claim 16, lines 5 and 8, Claim 22, line 3, Claim 23, lines 5 and 9, Claim 25, lines 5 and 10 and Claim 26 lines 3 and 8 – it is unclear what is meant by the phrased "radially spaced" longitudinal slots because it appears from the drawing that all the slots are placed at the same radial distance from a longitudinal axis passing through the either the connector or the tubes. It appears that the slots are instead circumferentially spaced around the surface of the connector or the pipes.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1, 3-4, 16-18 and 22 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 98/22690.

In regard to claim 1, WO 98/22690 discloses an expandable tubing assembly (fig. 1) comprising a tubular connector 1 defining overlapping longitudinal slots (see page 3, lines 13-14) and comprising an intermediate portion (area where 1 is pointing in fig. 1) located between slotted end portions, the connector being radially expandable by deformation of fingers of material in the intermediate portion where adjacent circumferentially spaced slots overlap, and lengths of expandable tubing 2, 3 defining overlapping longitudinal slots with nodes beyond the ends of the slots and having slotted end portions, the tubing being radially expandable by deformation of fingers of material where adjacent circumferentially spaced slots overlap.

Wherein the slotted end portions of the connector 1 are threaded to the nodes of respective end portions (threaded via screws 11) of the tubing lengths and the deformable fingers of the connector are axially spaced from the end most deformable fingers of the respective tubing lengths.

In regard to claim 3, the intermediate portion 1 is of corresponding configuration of the tubing lengths, such that expansion characteristics of the connected tubing assembly are substantially constant.

In regard to claim 4, the connector intermediate portion 1 is of substantially the same wall thickness of the tubing 2, 3 and wherein the connector end portions are upset (the connector ends are raised above the surface of the tubes).

In regard to claim 16, WO 98/22690 discloses an expandable tubing assembly, comprising:

A first and second tube 2, 3 having a plurality of longitudinal slots 4 formed therein;

A connector 1 threadably disposed (threaded by 11) between the first 2 and second 3 tubes, wherein the connector comprises;

first and second ends having a plurality of radially spaced, longitudinal slots 4 formed therein, and

an intermediate portion (area where 1 is pointing) located between the first and second ends having a plurality of radially spaced, longitudinal slots 4 that at least partially overlap the slots formed in the first and second ends (see page 3, lines 13-14).

In regard to claim 17, the slots formed in the first tubular, the second tubular, and the intermediate portion are expandable.

In regard to claim 18, the slots formed in the first tubular, the second tubular, and the intermediate portion are expandable to form substantially diamond shaped apertures (see page 3, line 15).

In regard to claim 22, the connector is attached to the first and second tube using one or more means 11 for connecting disposed between the radially spaced, longitudinal slots formed in the first and second ends of the connector.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5-6, 19-21 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/22690 in view of Kozono et al. WO 98/22690 discloses an assembly as described above. However, WO 98/22690 does not disclose that each end portion defines an internal thread for engaging a corresponding thread on an outer surface of each tubing end portion, or that the connector end portions define grooves to receive corresponding tongues provided on the tubing length of the end portions. Kozono et al. teaches providing inner threads at both ends of a connector 21, and external threads on adjacent pipe ends in order to create a strong connection between two tubes 11 which can be quickly assembled. Kozono et al. also teaches providing grooves 29 and tongues 28 in order create a better seal between the connector and the tubular members. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the connector of WO 98/22690 to include mating internal and external threads with a groove and tongue arrangement in order to create a strong connection that can be assembled quickly and provide a good seal between the mating members.

Conclusion


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Bochna whose telephone number is (703) 306-9040. The examiner can normally be reached on 8-5:30 Monday-Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H. Browne can be reached on (703) 308-1159. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.


David Bochna
June 11, 2002